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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,638	07/30/1999	EIJI KAWAI	450127-02126	9709

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/364,638

Applicant(s)

KAWAI, EIJI

Examiner

Tammara R Peyton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45, 46, 48-56, 58-65, 67-75 and 77-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45, 46, 48-56, 58-65, 67-75, 77-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 03/17/05
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45, 51, 55, 61, 65, 71, 75, and 80 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 08-171488, as filed 03/17/05 as prior art.

As per claims 45 and 55, JP 08-171488 teaches an information processing apparatus (Fig.1) comprising:

- a processor (Fig.2) for executing a booting program to start up said information apparatus; and
- a non-removable data storage (ROM, 5, Fig.1) locating in said information processing apparatus for storing said booting program and first data, accessible by said booting program; and another data storage for storing second data accessible by said booting program, the other data storage comprising a recording medium removably connected to said information processing apparatus,
- wherein said processor selectively uses said first data stored in said non-removable data storage or said second data (ROM, 4, 4a, Fig. 1) stored in

said other data storage according to said booting program to start up said information processing apparatus, said other data storage being capable of data communication with said information processing apparatus.

(Abstract)

As per claims 51 and 61, JP 08-171488 teaches information processing apparatus (Figs.1, 2) comprising:

- a processor (Fig.2) for executing a booting program to start up said information apparatus; and
- a communication unit (inherent) for data communication with a plurality of data storages for storing data, one of said data storages being a non-removable data storage located in said information processing apparatus for storing said booting program, and at least one of said other of data storages being capable of data communication with said information processing apparatus,
- wherein said processor selectively uses said data stored in said plurality of data storages according to said booting program to start up said information processing apparatus. (Abstract)

As per claims 65, 71, 75, and 80, JP 08-171488 teaches a method of starting up an information processing apparatus, with a recording medium removably inserted therein, comprising the steps of:

- transmitting variable boot data to the information processing apparatus, to be executed according to a boot sequence by the information processing apparatus which executes a program to process data, said variable boot data being stored in a recording medium that is removably inserted in the information processing apparatus; and
- storing invariable boot data in a non-removable boot execution storage means located in the information processing apparatus; and
- selectively booting the information processing apparatus according to the booting sequence based on one of said variable boot data transmitted from said recording medium and said invariable boot data in said boot execution storage means. (Abstract)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46, 48-50, 52-54, 56, 58-60, and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-171488 and *Hsu*, (US 5,785,598).

As per claims 46, 48, 49, 52, 54, and 58, JP 08-171488 teaches a system wherein the immediate execution of the external program in the selected external storage can be carried out to a power up, and when the system software is not operating normally, the various programs in external storage can be performed by using the booting sequence in the external storage.

However, JP 08-171488 does not expressly teaches wherein the first data storage and the second data storage includes at least one of image data and sound data and replacing the image and sound data stored in the first data storage with the second data storage. *Hsu* teaches wherein a processor selectively executes using either a first data store, from an existing game cartridge, (200, Figs. 1, 2) or a second data store, from add-on card (300, Fig.2) according to said booting control program to start up said information processing apparatus. (col. 4, lines 6-16) It would have been obvious to one of ordinary skill at the time the invention was made that *Hsu's* teaches a booting sequence that implements a software routine to load a boot program for starting up said information processing apparatus from either the first data store or the second data store. *Hsu* also teaches wherein said other data storage is capable of data communication with said information processing apparatus.

Hsu teaches wherein the first data storage includes at least one of image data and sound data but does not expressly teach wherein the other data storage for storing said second data is a recording medium removably connected to said information processing apparatus also includes image and sound data. *Hsu's* game console (50) includes an audio outlet (via 13, Fig. 2) and a video outlet (via 15, Fig. 2) for outputting

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sound and image data for an inserted video game cartridge. It is well known in the art at the time the invention was made that video game cartridge's include sound and image programs that are used in accordance with a game console's audio and video outlets. *Hsu* teaches wherein the second data storage includes additional image programs for a video game cartridge related to the first data storage wherein the first data storage includes video game data for the related video game cartridge, therefore, one of ordinary skilled in the art would readily recognize that the second data storage includes additional programs including at least one image data and sound data related to the first data storage that will be outputted via the game console's audio and video outlets.

It would have been obvious to one of ordinary skill at the time the invention was made to implement a booting sequence that includes additional programs including at least one image data and sound data and therein replaces the booting sequence stored in the first data storage with the booting sequence stored in the second data storage as taught by *Hsu* with JP 08-171488 because doing so would add and expand the flexibility of JP 08-171488 booting sequence by including additional programs that can replace the current booting sequence.

As per claims 50, 53, 60, and 63, JP 08-171488 teaches wherein the other data storage is a portable electronic device (4, 4a, Fig.1) and *Hsu* also teaches wherein the other data storage is a portable electronic device (Smart card, 300b, Fig. 3b)

As per claims 56, 62, and 64, *Hsu* teaches wherein said first and second data are image data and displaying an image of the selected image data on a display according to said booting program in starting up said information processing apparatus.

As per claim 59, *Hsu* teaches a method wherein an image of said first data is displayed on a display (television set, 18) in starting up said information processing apparatus when said recording medium is not connected to said information processing apparatus, and an image of said second data is displayed on said display in starting up said information processing apparatus when said recording medium is connected to said information processing apparatus.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

USTPO, 2011 South Clark Place, Customer Window

Crystal Plaza Two, Lobby Room 1B03, Arlington, VA, 22202Crystal Park II, 2121.

A handwritten signature in cursive script, appearing to read "Tammara Peyton".

Tammara Peyton

May 13, 2005